

REMARKS

At the time of the Final Office Action dated December 24, 2008, claims 1, 5, 9-12 and 16-18 were pending in this application. Claims 1, 5, 9-12 and 16-18 have been rejected, claims 1, 5 and 12 are amended and claims 2-4, 6-8 and 13-15 were canceled without prejudice and without waiver of subject matter.

CLAIMS 1, 5, 9-12 AND 16-18 ARE REJECTED UNDER U.S.C. § 102 FOR ANTICIPATION BASED UPON JUDGE, U.S. PATENT NO. 7,096,498 (HEREINAFTER JUDGE)

On pages 2-6 of the Final Office Action, the Examiner asserted that Judge discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.²

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. ... The second step in the

¹ *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

² See *In re Spada*, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

analyses requires a comparison of the properly construed claim to the prior art."³ During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification,"⁴ and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.⁵ Therefore, the Examiner must (i) identify the individual elements of the claims and properly construe these individual elements,⁶ and (ii) identify corresponding elements disclosed in the allegedly anticipating reference and compare these allegedly corresponding elements to the individual elements of the claims.⁷ This burden has not been met.

Claim 1

Independent claim 1, in part, recites "a plurality of cooperative spam control processors, each of said plurality of cooperative spam control processors coupled to a corresponding one of said e-mail clients, wherein said plurality of cooperative spam control processors are configured to detect spam and to notify others of said plurality of cooperative spam control processors of said spam; and, a group administrator for a group of e-mail clients, said group administrator having authority to establish an agreement to exchange spam notifications with another group administrator of other groups of e-mail clients having respective cooperative spam control processors. To teach these limitations, on pages 2-3 the Office Action, the Examiner asserted the following:

³ Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

⁴ In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

⁵ In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

⁶ See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); see Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

⁷ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

1 wherein said cooperative spam control processors comprises programming for detecting spam
2 and for notifying others of said cooperative spam control processors of said spam (see e.g. col. 7,
3 lines 19-20); and a group administrator for said e-mail clients, said group administrator having
4 authority to establish an agreement to exchange spam notifications with other groups of e-mail
5 clients having respective cooperative spam control processors (see e.g. col. 19, lines 13-16.
6 (emphasis added).
7

8 For the convenience of the Examiner, the cited portion of Judge is reproduced below:

9 As a non-limiting example, natural language output can be used to explain to an
10 administrator or user how to configure the system with the suggested rules and policies.
11

12 Applicants do not see how the “natural language output can be used to explain to an
13 administrator or user how to configure the system with the suggested rules and policies” can be
14 construed as disclosing “a group administrator for a group of e-mail clients, said group
15 administrator having authority to establish an agreement to exchange spam notifications with
16 another group administer of other groups of e-mail clients having respective cooperative spam
17 control processors.” First, there is no mention of a group administrator for a group of e-mail
18 clients.” Second there is no mention of a first group administrator for a group of e-mail clients
19 establishing “an agreement” to exchange spam notifications with another group administer of
20 other groups of e-mail clients as recited in amended claim 1. Applicants maintain that all
21 limitations of amended claim 1 must be found in Judge in order for the Examiner to establish a
22 prima facie case of anticipation. Accordingly, Applicants respectfully submit that claims 1, 5, 9-
23 12 and 16-18 are not anticipated by the applied prior art. Thus, Applicants respectfully submit
24 that a rejection of claims 1, 5, 9-12 and 16-18 for anticipation based upon Judge is not viable.
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26 On page 5, paragraph 14 of the Office Action, the Examiner asserted the following:

27 14 However, it is noted that this language "cooperative spam control processor comprises
28 programming" means that the remaining portion ("for detecting spam and for notifying others of said
29 cooperative spam control processors of said spam") has questionable patentable weight. This does not
30 reflect the programming directly, but states what the capability, or intended use, of the processor is. As
31 such, any general purpose processor fulfills this functionality, as a general purpose processor has

programming that enables a processor to perform the claimed functionality when it is provided with the commands to perform the functionality. **Applicant should amend the instant claim** to clearly require that the processor performs the functionality, rather than having programming for performing the functionality, or having the programming in some memory, that when executed by the processor, perform the functionality

Applicants have amended claim 1 as suggested by the Examiner.

On page 6, paragraph 17 of the Office Action, the Examiner asserted the following:

The portion cited to reject this limitation was Judge, column 19, lines 13-16. This portion discloses that an administrator can configure the system with rules and policies. As rules and policies can be established, the administrator has the authority to establish the agreement as claimed. **There is no requirement as to what constitutes the agreement or who the agreement is between.** This agreement, as currently claimed, appears to simply be a policy that dictates that spam notifications are exchanged with other groups of clients, where the administrator has authority to establish policies. Applicant should amend the instant claim to clearly demonstrate how the agreement is established.

Applicants have amended claim 1 to include “a group administrator for a group of e-mail clients.” Moreover, Applicants have amended claim 1 to include a first “group administrator for a group of e-mail clients establishing an agreement to exchange spam notifications with another group administer of other groups of e-mail clients.” Judge fails to identically disclose all the limitations of amended claim 1 and therefore fails to establish a prima facie case of anticipation.

Claims 2-6 and 8-13

Claims 5, 9-12 and 16-18 all recite the limitations of:

obeying said notification if said rules indicate that notifications from said peer e-mail recipient are to be obeyed;
ignoring said notification if said rules indicate that notifications from said peer e-mail recipient are to be ignored; and,
overriding said notification where said e-mail message meets criteria established in said policy for overriding a spam notification.

Accordingly, for at least the reasons discussed with respect to amended Claim 1, Claims 9-12 and 16-18 are patentable over Judge, and allowance is respectfully requested.

Applicants have made every effort to present claims that distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-3829, and please credit any excess fees to such deposit account.

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Respectfully submitted,

/Steven M. Greenberg/

Steven M. Greenberg

Reg. No.: 44,725

Adam C. Underwood

Reg. No.: 45,169

Customer Number 46322

Tel: (561) 922-3845